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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/628,804 07/28/00 VENET

N Q60260

EXAMINER

QM12/0425

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TUGRANG, D

ART UNIT

PAPER NUMBER

3729

DATE MAILED:

6
04/25/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.

09/628,804

Applicant(s)

VENET ET AL.

Examiner

Dexter Tugbang

Art Unit

3729

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) 4-7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 July 2000 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of the invention of Group I, in Paper No. 4 is acknowledged.
2. Claims 4-7 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 5.

Drawings

- 0.16
3. The drawings are objected to because the drawing is not labeled as "Figure 1".
Correction is required.

Specification

4. The abstract of the disclosure is objected to because the abstract is not in one, single paragraph, but multiple paragraphs. Correction is required. See MPEP § 608.01(b).
5. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 250 words. It is important that the abstract not exceed 250 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

6. The disclosure is objected to because of the following informalities: On page 4 of the specification within the *Brief Description of the Drawing*, there is no reference to Figure 1.

Although Applicants disclose only one single figure, this should be referred to as **Figure 1**.

Appropriate correction is required.

7. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: A Method of Obtaining a Module including an Inductive Winding.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 contains ambiguous claim terminology which is unclear whether later recitations of originally recited terms are intended to refer to the originally recited terms. For example, the phrases of "a winding" (line 6) and "parallel and/or coaxial windings" (line 7) is unclear if these are referring to such phrases of "a winding" and "parallel and/or coaxial windings" (lines 3-4) previously recited in the preamble. Are each of these phrases referring to the same windings or totally and completely different windings?

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The Claims are replete with numerous phrases that lack positive antecedent basis and lack positive recitations. For example in Claim 1, the phrases of “ the edge” (line 8), “the stacked assembly” (line 9), “the molded block” (line 10), and “they” (line 11) all lack positive antecedent basis. Also in Claim 2, the phrase “ the associated modular elements” (line 6) lacks positive antecedent basis.

Furthermore in Claim 1, the replete alternative language of “or” (4 occurrences at lines 6-8 and 14) combined with the alternative language of “and/or” (line 7), make it impossible to determine as to what relationship exists between the claimed elements, i.e. the claimed “printed circuit elements” (line 5), “winding” (line 6), “windings” (line 7), “tracks” (line 7), etc. This multitude of alternative language in one single claim renders the claim as being vague, indefinite, confusing and misleading.

The Examiner has carefully reviewed all the pending claims in order to particularly point out examples of indefiniteness within the claims. The Applicants are reminded that upon amending the claims, and this includes newly added claims, that it is the Applicants’ responsibility to particularly point out and distinctly claim the subject matter with which the Applicants’ regard as their invention.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-3, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Lugten, 3,483,499, Val et al 5,640,760, and European Patent Publication EP 782,154, referred to hereinafter as EP'154.

Lugten discloses a method of manufacturing a module comprising: stacking a plurality of aligned modular printed circuit elements (primary winding shown in Fig. 3a) and supplementary modular printed circuit elements (secondary windings shown in Fig. 3b), each forming part of multiple windings with tracks terminating on an edge side surface thereof (see Figs. 2 and 4); creating connections on faces of the side surfaces to connect them to connection means T1, T2, T3, T4; and forming a square shaped orifice -V- (in Fig. 2) adapted to enable a conduit of a core 12, 13 to be inserted through the modular elements.

Lugten further suggests that it is conventional in the art to mold the entire stacked assembly with an encapsulating material, which when the encapsulated material is dried, would form a rigid block (discussed at col. 4, lines 56-57).

Lugten does not mention the molding material is composed of an insulative material or the step of cutting the molded block to expose conductive tracks.

Val teaches the formation of a molded block with polymerizable resin which is subsequently cut at slicing planes 23 within a stacked block (see Figs 2c and 3) to purposely expose conductive tracks 25 on side surfaces of the cut block material. Such an advantage of this process allows the electrical interconnection with other electrical circuits (see col. 3, lines 47-55).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Lugten method by including the step of cutting the molded block,

as taught by Val, to positively expose conductive tracks on side surfaces of a stacked block material and also advantageously allow for the electrical interconnection of the block module with other electrical circuits.

EP'154 teaches in various embodiments an inductive module with which an electrically insulating resinous material 55 is formed over the module to electrically insulate the module (see col. 4, lines 27-29).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Lugten by molding or encapsulating the stacked module assembly with the insulating material of EP'154, to electrically insulate the module.


Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dexter Tugbang whose telephone number is 703-308-7599. The examiner can normally be reached on Monday - Friday 7:00 am - 4:30 pm.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

adt
April 22, 2001


4/22/01
LEE YOUNG
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TECHNOLOGY CENTER 3700